

REMARKS

The Examiner notes that only the titles of the applications that were co-filed with the present application are listed in the cross-references section of the application. The applicants apologize for the inconvenience this may have caused the Examiner; however, since the applications were all filed on the same day only their titles were available to identify them. As requested by the Examiner, the applicants have updated the reference information with an amendment to the specification above. Specifically, the titles originally named can be further identified as follows:

U.S. Patent No. 6,788,941 granted September 7, 2004 entitled "METHOD AND APPARATUS FOR MOBILE-INITIATED, CDMA-DISPATCH SOFT HANDOFF,"

U.S. Serial No. 10/027,488 entitled "METHOD AND APPARATUS FOR CDMA-DISPATCH SOFT HANDOFF,"

U.S. Serial No. 10/027,193 entitled "METHOD AND APPARATUS FOR QUICKLY ESTABLISHING A CDMA DISPATCH CALL," and

U.S. Patent No. 6,801,783 granted October 5, 2004 entitled "BASE SITE AND METHOD FOR QUICKLY ESTABLISHING A CDMA DISPATCH CALL."

Claims 1-7, 13-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chinitz (U.S. Patent Number 5,914,958) in view of Han (U.S. Patent Number 6,321,089) and claims 8-12, 20 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chinitz in view of Han and further in view of McKenna (U.S. Patent Number 6,594,498). Respectfully disagreeing with these rejections, reconsideration is requested by the applicants. Nonetheless, the applicants have amended the claims above to more clearly highlight the patentability of the present invention over the prior art.

Regarding the rejection of claims 8-10 and 20-21, the Examiner cites McKenna column 16, lines 14-17 as teaching the claim language. Column 16, lines 11-17 reads:

A Pre-pay Subscription communique service is conceptually similar to the digital TV recorders that have a one-time-only pre-pay subscription fee. This concept uses a modified forward paging channel to provide initialization information for traffic channels and then uses in-band signaling on the forward traffic channel to convey systems information.

As amended, independent claim 1 recites, "transmitting the dispatch call via the first outbound link...indicating to the MS an **identity of the at least one base site and an identity of an outbound link for the dispatch call at the at least one base site, wherein the step of indicating the identity of the at least one base site and the identity of an outbound link comprises signaling in a manner included in the group consisting of signaling in-band on the first outbound link and signaling via a paging channel**" (emphasis added). As amended, independent claim 14 recites, "adapted to instruct the transmitter to transmit the dispatch call via the first outbound link...and adapted to indicate to the MS using the transmitter an **identity of the at least one base site and an identity of an outbound link for the dispatch call at the at least one base site, wherein the controller instructs the transmitter to transmit signaling to indicate the identity of the at least one base site and the identity of an outbound link in a signaling manner included in the group consisting of signaling in-band on the first outbound link and signaling via a paging channel**" (emphasis added).

Thus, the applicants submit that the cited art fails to teach all of the limitations of either independent claims 1 or 14. The claims **specifically** describe indicating to the MS an identity of the at least one base site and an identity of an outbound link for the dispatch call at the at least one base site. Moreover, the claims describe conveying this **specific information** either by signaling in-band on the first outbound link (which is also used for transmitting the dispatch call) or by signaling via a paging channel. In contrast, McKenna describes **very generally** using a "modified forward paging channel to provide **initialization information** for traffic channels and then uses in-band signaling on the forward traffic channel to convey **systems information**" (emphasis added).

Furthermore, the use of McKenna with Chinitz and Han is problematic because of a lack of sufficient motivation to combine these references. The Examiner appears to assert that the motivation for combining these references is "for the advantage of conveying system information" (see the present Office Action, bottom of page 8). The

applicants submit that this motivation is too generic. We submit that a person of skill in the art could combine the concepts taught by McKenna, Chinitz and Han in many new and non-obvious ways that would involve conveying system information and would be motivated by the desire to convey system information. This is true because "the advantage of conveying system information" is a very general motivation and a motivator for a great many things that are done in the communications industry as a whole.

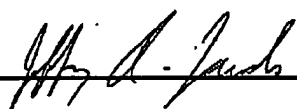
Therefore, the applicants submit that the motivation to convey system information is not a sufficient motivation to combine the particulars of McKenna, Chinitz and Han in the manner proposed by the Examiner. The Examiner may not use a hindsight analysis of the present application to support a *prima facie* case of obviousness. However, the applicants submit that substantial hindsight is required to combine the specific teachings of McKenna with the specific teachings of Chinitz and Han, in the particular way proposed, to achieve the functionality recited in claims 1 and 14.

In addition, we submit that the Examiner has failed to provide support in the prior art for the asserted motivation to combine. For the Examiner to establish a *prima facie* case of obviousness, the Examiner must provide a teaching or suggestion from the prior art to combine the references. The applicants respectfully request the Examiner either to provide a teaching or suggestion from the prior art to combine the cited references or to withdraw the rejection.

Since none of the references cited, either independently or as allowed in combination, teach all of the limitations of independent claims 1 or 14, or therefore, all the limitations of their respective dependent claims, it is asserted that neither anticipation nor a *prima facie* case for obviousness has been shown. No remaining grounds for rejection or objection being given, the claims in their present form are asserted to be patentable over the prior art of record and in condition for allowance. Therefore, allowance and issuance of this case is earnestly solicited.

The Examiner is invited to contact the undersigned, if such communication would advance the prosecution of the present application. Lastly, please charge any additional fees (including extension of time fees) or credit overpayment to Deposit Account No. 502117 – Motorola, Inc.

Respectfully submitted,
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By: _____

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